

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. APPLN. NO. 09/614,592  
ATTY. DOCKET NO. Q60082

independent form, Applicant respectfully traverses the prior art rejections for the reasons set forth below.

1. Claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sawahashi *et al.* (U.S. Patent No. 6,069,912) in view of Ono (U.S. Patent No. 6,272,167). Applicant traverses the rejection of claim 1 for at least the reasons discussed below.

The combination of Sawahashi *et al.* and Ono fails to teach or suggest at least a weighted-mean-value processor that weights and adds the correlation signals output from correlation processors, and then averages the weighted and added correlation signals for a predetermined number of times, as recited in claim 1. At best, the combination of Sawahashi *et al.* and Ono discloses a path search circuit that comprises a weighted-mean-value processor that weights and adds correlation signals output from a plurality correlation processors, and then level adjusts the weighted and added correlation signals. There is no teaching or suggestion of averaging weighted and added correlation signals for a predetermined number of times in either Sawahashi *et al.* or Ono. For example, in the Response to Arguments section of the January 7, 2005 Final Office Action, the Patent Office asserts that Sawahashi *et al.* discloses averaging weighted and added correlation signals for a predetermined number of times through the use of a level adjuster circuit (508). *See, e.g.*, Figure 5, col. 9, line 15 of Sawahashi *et al.* There is no disclosure in Sawahashi *et al.* that the level adjuster circuit does anything more than adjust the level of the input signal into the phase fluctuation compensator (510). While the input signal to the level adjuster circuit is from an adder circuit (507) that receives inputs from a plurality of

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mixer and matched filters, Sawahashi *et al.* is silent with respect to any averaging function carried out by the level adjuster circuit for a predetermined number of times. Even assuming *arguendo* that the level adjuster circuit operates in the manner alleged by the Patent Office (*i.e.*, dividing the output signal from the adder (507) by the number of receiving antennas (M)), the multipliers (506A-506C, the adder (507) and the level adjuster circuit of Sawahashi *et al.* do not weight and add correlation signals, and then average the weighted and added correlation signals for a predetermined number of times, as recited in claim 1. Ono is similarly unavailing with respect to the averaging of weighted and added correlation signals. For example, correlation signals are input into a plurality of weighting circuits (130), and the outputs of the weighting circuits are input into a RAKE combiner unit (400). *See, e.g.*, Figure 1 of Ono. There is no disclosure that the weighted correlation signals are summed together and averaged for a predetermined number of times in any manner. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

Applicants submit that one of skill in the art would not be motivated to combine the two references. *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) requires the Patent Office to provide particularized facts on the record as to why one of skill would be motivated to combine the two references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). Although the Patent Office provides a motivation analysis with respect to Ono’s alleged disclosure of reception level and timing for a detected peak, both Sawahashi *et al.* and Ono lack any teaching

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about the desirability of a weighted-mean-value processor that weights and adds correlation signals and then averages the weighted and added correlation signals for a predetermined number of times, a motivation to combine is lacking. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Sawahashi *et al.* and Ono fails to teach or suggest all of the claimed elements as arranged in claim 1. Thus, Applicants submit that claim is allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 1.

2. Claims 7 and 9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sawahashi *et al.* in view of Ono and in further view of Dobbins *et al.* (U.S. Patent No. 5,730,272). Applicant traverses the rejection of claims 7 and 9 for at least the reasons discussed below.

Claims 7 and 9 depend from independent claim 1, and therefore incorporate all of the features thereof. Applicant submits that Dobbins *et al.* fail to cure the deficiencies of the combination of Sawahashi *et al.* and Ono as discussed above regarding claim 1. Thus, Applicant submits that claims 7 and 9 are allowable at least by virtue of their dependency from independent claim 1, and respectfully requests that the § 103(a) rejection of claims 7 and 9 be withdrawn.

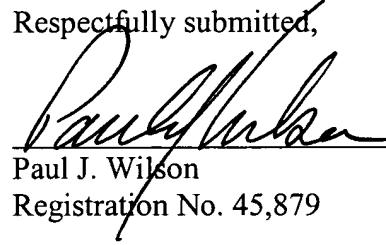
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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